

REMARKS

The Office Action dated December 22, 2000, has been received and its contents carefully considered. The rejections contained therein are addressed, in turn, below.

1. Status of the Claims

Claims 20-47 are pending in this application. Claim 38 has been amended in response to the Examiner's rejection under 35 U.S.C. §112 to remove a single element of the enumerated group, but not to modify in anyway the scope or meaning of the remaining enumerated species. No new matter has been added.

2. Rejections under 35 U.S.C. §112

The rejection of Claim 38 as indefinite under 35 U.S.C. §112 is moot in light of the above amendment, which was suggested by the Examiner. Accordingly, reconsideration and withdrawal of the rejection is requested.

3. Rejections under 35 U.S.C. §103

Claims 20-47 have been rejection as obvious under 35 U.S.C. §103. The specific rejections will be addressed in detail below. However, as a preliminary matter, relevant standards for establishing *prima facie* obviousness are first discussed.

Standards for Establishing *Prima Facie* Obviousness

In order to demonstrate *prima facie* obviousness under 35 U.S.C. §103, the Examiner must establish that (1) the reference(s) teaches or suggests all of Applicant's claim limitations; (2) there is some suggestion or motivation, either in the references themselves, or in the knowledge of those of ordinary skill in the art, to modify or combine the references in the manner proposed by the Examiner; and (3) there is a

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reasonable expectation of success in such a modification or combination. See M.P.E.P. §2143.

These criteria must be established with actual evidence that is both clear and particular, and not merely based on broad conclusory statements. See *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("the showing must be clear and particular... Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'") (internal citations omitted).

Furthermore, prior art references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); M.P.E.P. §2142.01. That is, the portions of the reference which teach away from the suggested combination must be considered and given weight.

Finally, with respect to the obviousness of chemical compositions, it has been recognized by The Federal Circuit that the chemical arts are unpredictable and that "generalization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other... there must be adequate support in the prior art for the... change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant." *In re Grabiak*, 226 USPQ 870, 872 (Fed. Cir. 1985).

U.S. Patent No. 5,766,576 to Lowe et al.

Claims 20 - 24 and 26 - 47 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,766,576 to Lowe et al. (Lowe). As a preliminary matter,

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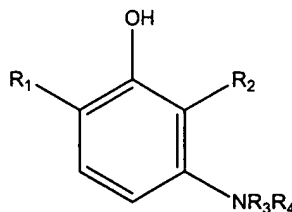
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Applicants note that Lowe is identified in the Office Action as U.S. Patent No. 5,776,567, and assume that the citation is actually U.S. Patent No. 5,766,576, as indicated on Applicant's form PTO-1449.

Applicants respectfully disagree with the rejection since, as not all of the required criteria have been satisfied with the requisite specificity, *prima facie* obviousness has not been established. Thus, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

First, it is argued in the Office Action that "Lowe's preferred couplers include the claimed 4-amino-5-fluoro-2-hydroxytoluene, and 5-amino-2methylphenol (which differs from the claimed coupler only in that it does not contain a fluoro group)." Office Action, page 3, lines 6-8. However, the differences between the couplers of Lowe and those of the claimed invention have not been fully appreciated.

The couplers of the claimed invention are halogenated meta-aminophenols of formula (I):

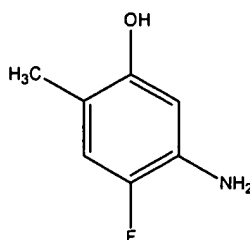


where at least one of R₁ and R₂ is a halogen, and as further defined in the present claims. Among the distinguishing features of the claimed formula (I) are: (1) a halogen is necessarily ortho to the hydroxy, (2) the amino group is necessarily meta to the hydroxy group, and (3) a halogen is located either (i) between the amino and hydroxy groups, or (ii) para to the amino group.

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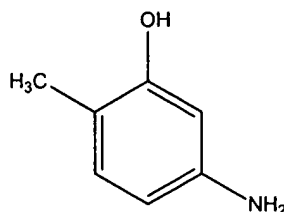
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The structure of Lowe's 4-amino-5-fluoro-2-hydroxytoluene is shown below:



As can be seen from its structure, 4-amino-5-fluoro-2-hydroxytoluene differs from the structure of formula (I) in that, at least, (1) the halogen group is not ortho to the hydroxy group, and (2) the halogen is not located either (i) between the amino and hydroxy groups, or (ii) para to the amino group. Thus, Lowe's 4-amino-5-fluoro-2-hydroxytoluene is clearly different than the claimed coupler according to formula (I) of the present invention. The suggestion in the Office Action that 4-amino-5-fluoro-2-hydroxytoluene is a claimed species of the present invention is erroneous.

The structure of Lowe's 5-amino-2-methylphenol is shown below:



As can be from the structure, Lowe's 5-amino-2-methylphenol differs from formula (I) of the present invention in that, at least, (1) there is no halogen group, (2) there is no halogen group ortho to the hydroxy, and (3) there is no halogen located either (i) between the amino and hydroxy groups, or (ii) para to the amino group. Thus, Lowe's 5-amino-2-methylphenol is an entirely different chemical species than the claimed coupler according to formula (I) of the present invention.

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Accordingly, since Lowe fails to teach or suggest the claimed coupler according to formula (I) of the present invention or provide support for modifying any disclosed coupler to yield a coupler according to formula (I), Lowe fails to render obvious claims 20 - 24 and 26 - 47. Any mere similarities between Lowe's couplers and those of the claimed invention are not sufficient since "there must be adequate support in the prior art for the... change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant." *In re Grabiak*, 226 USPQ at 872.

Second, Applicants respectfully assert that the Examiner has not based the suggested modification on any knowledge that was within the level of ordinary skill at the time the claimed invention was made. Certainly, the Examiner has not cited any such knowledge. Rather, the only source on record for the claimed composition comprising the claimed coupler is found within the present application, and not the cited reference. However, reliance on an applicant's disclosure to modify prior art references constitutes impermissible hindsight, and cannot serve as the basis for a *prima facie* case of obviousness. See, for example, M.P.E.P. §2142.

Accordingly, for any or all of these reasons, the Office has failed to establish a *prima facie* case of obviousness based on Lowe against the present invention.

U.S. Patent No. 3,918,896 to Kalopissis et al. in view of U.S. Patent No. 5,061,289 to Clausen et al.

Claims 20 - 47 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,918,896 to Kalopissis et al. (Kalopissis) in view of U.S. Patent No. 5,061,289 to Clausen et al. (Clausen). For at least the following reasons, this rejection is respectfully traversed.

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First, it is argued in the Office Action that “[i]t would have been obvious to... substitute the p-aminophenol oxidation base of Kalopissis... with a diaminopyrazole as claimed... because Clausen teaches that the claimed diaminopyrazoles are an improvement over p-aminophenol.” Office Action, page 5, lines 8-12. However, the suggested modification is directly contrary to the express teachings of Kalopissis. Specifically, Kalopissis teaches: “[t]he dye compositions according to the present invention are characterized by the following essential features:... they must contain a paraphenylenediamine or a paraaminophenol or a heterocyclic oxidation base such as 2,5 diaminopyridine or 2-hydroxyl-5-aminopyridine.” Col. 2, ln. 67 - col. 3, ln. 5 (emphasis added).

Thus, based on the express teachings of Kalopissis, one cannot replace p-aminophenol with Clausen’s diaminopyrazole because p-aminophenols are taught to be an essential feature of Kalopissis’s composition. Accordingly, since Kalopissis teaches away from the Examiner’s suggested combination, the suggestion is inherently flawed and fails to support a *prima facie* case of obviousness against the present invention.

Second, the suggested combination is also contrary to the teachings of Clausen. Specifically, the disclosure of Clausen clearly teaches that the compositions disclosed therein solve problems of the prior art “in an outstanding manner” (col. 1, line 64) and that it relies on a preferable group of couplers. These couplers, see col. 2, lines 30-44, have the following common features: (1) Not one of couplers has both amine and halogen functional groups, (2) not one of the couplers has both amine and halogen functional groups on a phenol species, and (3) not one of the couplers has both amine and halogen functional groups on a phenol species, where the amine group is meta

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relative to the hydroxy group. These distinguishing features clearly differentiate Claussen's couplers from those according to formula (I) of the present invention (see page 4 herein).

Thus, since Claussen clearly teaches that "outstanding" results can be obtained using a preferable selection of couplers (none of which are within the scope of the claimed couplers), Claussen clearly lacks any motivation to replace their preferred couplers with couplers within the scope of formula (I) of the present invention. That is, one skilled in the art would not be motivated to modify Claussen since Claussen already achieves "outstanding" results and there is no motivation to further modify the composition. In other words, Claussen teaches away from the suggested combination and fails to support a *prima facie* case of obviousness.

Finally, Applicants respectfully assert that the Examiner has not based the suggested modification on any knowledge that was within the level of ordinary skill at the time the claimed invention was made. Certainly, the Examiner has not cited any such knowledge. Rather, the only source on record for the suggested modification is found within the present application, and not the cited references. However, reliance on an applicant's disclosure to modify prior art references constitutes impermissible hindsight, and cannot serve as the basis for a *prima facie* case of obviousness. See, for example, M.P.E.P. §2142.

Accordingly, for any or all of these reasons, the Office has failed to establish a *prima facie* case of obviousness based on Kalopissis and Claussen against the present invention.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 16, 2001

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